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EXAMINER

ARAQUE JR, GERARDO

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/995,652
Filing Date: November 29, 2001
Appellant(s): KOJIMA ET AL.

Charles Gorenstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 8, 2008 appealing from the Office action mailed June 10, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,595,264	TROTTA, JR.	1-1997
7,114,656 B1	GARVER	10-2006
5,804,807	MURRAH ET AL.	9-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claim 14** is rejected under 35 U.S.C. 102(b) as being anticipated by **Trotta, Jr. (US Patent 5,595,264)**.

3. In regards to **claim 14**, **Trotta** discloses a portable terminal comprising:
tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area and customer identifying information written onto another wireless tag(**Fig. 4 #23**);

storage for accumulating and storing commodity information that has been read by the tag reader (**Fig. 4 #27**);

wireless communication device for transmitting commodity information to an information-processing apparatus via radio waves at the same time that the commodity

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information is stored in the storage, and transmitting the customer identifying information to the information-processing apparatus via radio waves (**Fig. 4 #40**); and display for displaying the commodity information that has been read out (**Fig. 4 #22**).

Further still, the Examiner considers customer identifying information to be nonfunctional descriptive subject matter since it does not affect how the apparatus functions, communicates, or stores information. The type of data adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art. As claimed, the steps of the invention would be performed the same regardless of the type of data used. As a result, the Examiner asserts that the portable terminal as disclosed by **Trotta** is fully capable of reading information via radio waves from multiple wireless tags.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1 – 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Trotta, Jr. (US Patent 5,595,264)** in view of **Garver (US Patent 7,114,656 B1)**.

6. In regards to **claims 1 – 3**, **Trotta** discloses a merchandise retail management method comprising the steps of:

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putting a tag on display together with a sample commodity in a display area, commodity information including an identification code of the commodity, being allowed to be read from the tag **(Col. 2 Lines 55 – 56)**;

lending out a portable terminal capable of reading the tag to a customer entering the display area **(Col. 3 Lines 56 – 57)**;

reading the commodity information from the tag, which is put on display together with the corresponding sample commodity, with the portable terminal when the customer indicates an interest in purchasing the commodity **(Col. 5 Lines 1 – 29)**;

storing the corresponding commodity information in the portable terminal and relaying it to an information-processing apparatus for merchandise management and sales management **(Col. 1 Lines 56 – 59; Col. 4 Lines 30 – 40; Col. 5 Lines 55 – 57)**;

comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information which is sent from the portable terminal to a POS apparatus at a sales counter and is then entered into the information-processing apparatus **(Col. 4 Lines 30 – 40; see also at least Col. 6 Lines 2 – 8; wherein the information processing apparatus is the in-store computer that keeps the running total of the customer's purchase [Col. 5 Lines 35 – 42] and receives the information as the customer is scanning the commodity and wherein the scanner terminal acts as the POS apparatus since it is the location where payment is finalized. Further still, a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would identify the scanner**

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with the customer, and when the scanner is placed back at the scanner terminal another type of identifier must then be transmitted from the scanner terminal to the in-store computer in order to compare that the two identifiers are the same in order to release the customer's payment card and the printing of the receipt of the total purchases.);

the customer returning the portable terminal when leaving **(Col. 6 Lines 2 – 4);**
and

handing over of the commodity to the customer after the commodity to be sold has been prepared in accordance with the comparison result of commodity information at the information-processing apparatus **(Col. 6 Lines 8 – 12).**

However, **Trotta** fails to teach:

putting a tag on display together with a sample commodity in a display area, commodity information including an identification code of the commodity, being allowed to be **written** to the tag.

Garver teaches a method and system similar to **Trotta** in that a portable terminal is provided to a customer in order to cut total shopping time by reducing the amount of time spent at checkout. **Garver** further discloses that it is also old and well known that various types of indicia, such as RFID tags, can be used to read and write the commodity information on the commodity **(Col. 3 Lines 18 – 20; Col. 5 Line 40)**. As a result, providing an RFID tag would allow for the RFID tag to be used multiple times because of their characteristic of having its data be rewritten and that they do not require an unobstructed line of sight between the tag and the reader **(additional**

information can be found at

http://whatis.techtarget.com/definition/0,,sid9_qci1038008,00.html).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention in view of the teaching of **Garver** to modify **Trotta** to have sample commodity with the corresponding RFID since they can be rewritten with new commodity information in order to reuse the tags and avoid purchasing new tags when replacing old commodities with new commodities or for a price change, as well as the additional benefit that an RFID tag does not require an unobstructed line of sight between the tag and the reader.

7. In regards to **claim 4**, although **the combination of Trotta and Garver** fails to disclose further comprising a rewriting apparatus for rewriting the commodity information on the wireless tag.

However, the Examiner asserts that it would have been obvious to one having ordinary skill in the art at the time of the invention that a rewriting apparatus to be obviously included since an RFID tag requires some type of read/write device so that the information can be stored on the RFID tag (**additional information can be found at http://whatis.techtarget.com/definition/0,,sid9_qci1038008,00.html**).

Therefore, it would have been obvious to one having ordinary skill in the art for the **combination of Trotta and Garver** to disclose a rewriting apparatus for rewriting the commodity information on the wireless tag since an RFID tag requires some type of read/write device so that the information can be stored on the RFID tag.

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8. In regards to **claims 5 – 6**, **Trotta** discloses wherein the portable terminal includes:

input means with which the customer commands an arithmetic process relating to stored commodity information (**Col. 5 Lines 1 – 29**); and

arithmetic means for conducting arithmetic processing according to the command to the input means (**obviously included**).

9. In regards to **claim 7**, **Trotta** discloses wherein the portable terminal includes:

input means with which the customer designates stored commodity information (**Col. 6 Lines 33 – 35**); and

display means for displaying commodity information in accordance with the designation made to the input means (**Col. 4 Line 21**).

10. In regards to **claim 8**, **Trotta** discloses wherein the portable terminal relays commodity information to at least one of a POS apparatus and an information processing apparatus at the same time that the portable terminal reads out the commodity information from the wireless tag (**Col. 3 Lines 8 – 11; see also at least Col. 4 Lines 30 – 40; see also at least Col. 6 Lines 2 – 8**).

11. In regards to **claim 9**, **Trotta** discloses wherein the information-processing apparatus includes:

wireless communication means for wireless communication with the portable terminal held by a customer checking out (**Col. 3 Lines 8 – 11; Col. 4 Lines 15 – 20**); and

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customer specification means for specifying customers by wireless communication via the wireless communication means (**Col. 3 Lines 8 – 11; Col. 4 Lines 38 – 40**).

12. In regards to **claim 10**, **Trotta** discloses wherein the information-processing apparatus further includes:

commodity information readout means for reading out the commodity information stored in the portable terminal through wireless communication with the portable terminal via the wireless communication means (**Col. 4 Lines 38 – 40**);

display means for displaying a list of commodity information that has been read out by the commodity information readout means (**obviously included**);

correction input means for receiving corrected input from customers who have viewed the list displayed by the display means (**Col. 6 Lines 33 – 50**); and

commodity correction means for correcting commodity information in accordance with the corrected input when the corrected input means receives corrected input (**Col. 6 Lines 33 – 50**).

13. In regards to **claim 11**, **Trotta** discloses wherein the information-processing apparatus carries out revision and addition of information to the list through wireless communication with the portable terminal via the wireless communication means (**Col. 5 Lines 48 – 65**).

14. In regards to **claims 12 – 13**, **Trotta** discloses wherein the information-processing apparatus is further provided with payment processing means capable of processing payment for sales, displayed by the display means (**Col. 6 Lines 5 – 12**).

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15. **Claims 15 – 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Trotta, Jr. (US Patent 5,595,264)** in view of **Garver (US Patent 7,114,656 B1)** in further view of **Murrah et al. (US Patent 5,804,807)**.

16. In regards to **claims 15 – 16, the combination of Trotta and Garver** discloses that the scanner, which reads information via radio waves, is released from its holder to a customer after an authorized credit card, debit card or like payment is accepted

However, **the combination of Trotta and Garver** fails to explicitly disclose:

wherein the portable terminal reads via radio waves customer identifying information written onto another wireless tag, and transmits the customer identifying information-processing apparatus via radio waves.

Murrah discloses a similar system where any potential user is capable of using a portable terminal for scanning indicia off of products. **Murrah** further discloses an embodiment where a roving attendant uses the portable scanning terminal to create an itemized list of all items in a customers shopping cart. The roving attendant initiates a pre-register transaction by scanning or manually entering the customer's purchase record identifier, which is a store loyalty card, into the terminal. **Murrah** also discloses that the method for scanning indicia can be accomplished using radio frequency identification tags. From this teaching it can be seen that one having ordinary skill in the art would have realized from the teachings of **Murrah** that it was old and well known in the art for portable terminals to not only be capable of scanning information off of products through radio waves, but that customer identifying information can be scanned as well (**see at least Col. 3 Lines 5 - 7; Col. 4 Lines 6 – 23; Col. 7 Lines 63 – 67**).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify **the combination of Trotta and Garver** to have a portable terminal to further read customer identifying information written onto another wireless tag, via radio waves, as a means of creating a transaction record that would contain the customer identification which would be linked with the scanned commodity information.

(10) Response to Argument

Rejection under 335 USC 102

17. In response to applicant's argument that **Trotta** fails to disclose, "...a portable terminal comprising a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remove from a checkout area **and customer identifying information written onto another wireless tag...and transmitting the customer identifying information to the information-processing apparatus via radio waves...**", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is fully capable of performing the intended use, then it meets the claim.

The Examiner considers customer identifying information to be nonfunctional descriptive subject matter since it does not affect how the apparatus functions, communicates, or stores information. The type of data adds little, if anything, to the claim's structure, and, thus, does not serve as a limitation on the claims to distinguish over the prior art. As claimed, the steps of the invention would be performed the same

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regardless of the type of data used. As a result, the Examiner asserts that the portable terminal as disclosed by **Trotta** is fully capable of reading information via radio waves from multiple wireless tags.

Further still, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Specifically, the Examiner asserts that the portable device as disclosed by **Trotta** is fully capable of wirelessly reading data stored onto a wireless tag, store the data read from the tag, transmit the data to an external apparatus (information-processing apparatus) via radio waves, and display the read data. It is asserted that what the data describes does not affect how the portable device functions nor does it further limit and structure of the portable device.

Rejection under 35 USC 103

Claim 1

18. In regards to applicant's argument that **the combination of Trotta and Garver** fails to teach or suggest, "...comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information **which is sent from the portable terminal to a POS apparatus at a sales counter** and is then entered into the information-processing apparatus."

However, as discussed in detail above, the information processing apparatus is the in-store computer that keeps the running total of the customer's purchase [Col. 5 Lines 35 – 42] and receives the information as the customer is scanning the commodity and wherein the scanner terminal acts as the POS apparatus since it is the location where payment is finalized. The Examiner would like to clarify that the POS apparatus is meant to be the scanner terminal, i.e. base station, which the portable terminal is normally housed in and that the POS apparatus is not just the scanner terminal.

Trotta discloses that three pieces of equipment are in communication with one another in order to track/compare and complete the customer's transaction. As discussed in **Col. 5 Lines 35 – 42**, **Trotta** discloses that the information processing apparatus, the portable terminal, and the base station, which retains the customer's credit card, are in communication with one another and allows the customer to perform any desired transactions.

One of ordinary skill in the art would have recognized that the information that is scanned by the portable device is transmitted to the information processing apparatus in order to track the items that the customer desires to purchase, as well as to the base station, i.e. POS apparatus, in order to charge the credit card that is stored therein.

Further still, a comparison must be made since the file that is stored at the in-store computer must contain some type of identifier, which would identify the scanner with the customer, and when the scanner is placed back at the scanner terminal another type of identifier must then be transmitted from the scanner terminal to the in-store computer in order to compare that the two identifiers are the same in order to release

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the customer's payment card and the printing of the receipt of the total purchases. Moreover, such a comparison would also be necessary for the sole purpose of ensuring that the correct customer is being charged for the correct scanned items from the correct portable device at the correct base station. In other words, the commodity information that is being tracked by the information processing apparatus must match up with the commodity information that is being charged to the credit card at the base station.

As a result, the Examiner asserts that **the combination of Trotta and Garver** does, indeed, teach or suggest, "...comparing at the information-processing apparatus the commodity information which has already been relayed to the information-processing apparatus, with commodity information **which is sent from the portable terminal to a POS apparatus at a sales counter** and is then entered into the information-processing apparatus."

As a further note, if one were to continue to argue that **Trotta** fails to disclose the limitation of transmitting information from a portable device to a POS apparatus one of ordinary skill in the art looking upon **Garver** would have found it obvious to transmit information from a portable terminal to an information processing apparatus and a POS apparatus (self-checkout station; see at least Col. 6 Lines 2 – 8; Figure 1A, Figure 1B #50 Portable Device, #40 POS apparatus, #31 information processing apparatus).

Claims 2, 4 – 13, 15 – 16

19. The rejection for claim 2 is maintained for, at least, the reasons stated above. It is asserted by the Examiner that the applicant's argument towards claim 2 appear to

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rely on the previous argument that the prior art fails to teach or suggest the limitations of claim 1. It is asserted that the applicant has failed to set forth the reasons of why the **combination of Trotta and Garver** fails to teach the limitations as disclosed in claim 2.

Claim 3

20. The Examiner asserts that the applicant's arguments are similar in nature to those presented towards claim 1. In view of this, the rejection is maintained for the reasons set forth above.

Additionally, the Examiner notes that claim 3 is directed towards a system. In other words, the Examiner asserts that the claim is directed towards apparatuses in communication with one another and capable of transmitting and receiving data. Therefore, the Examiner asserts that the rejection is also maintained for the reasons stated for claim 14 above since the type of data that is being scanned, transmitted, and received is considered to be non-functional descriptive subject matter and that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is asserted that the prior art is, indeed, capable of performing the processes as set forth in claim 3.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Gerardo Araque Jr.

/Gerardo Araque Jr./

Examiner, Art Unit 3689

September 15, 2009

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